

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-40 are pending in the application. Upon entry of this Amendment, claims 1, 4, 6, 9, 10, 13, 16, 19, 22, 25-28, 31, 32, 36, 38 and 39 will be amended and claim 37 will be cancelled.

In the outstanding Office Action of March 7, 2006, the Examiner noted that objected-to claims 4, 9-21, 25-33 and 35 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. By this Amendment, claims 4, 9, 13, 19, 25, 28 and 32 have been amended to place them in independent form. Claims 6, 7, 10-12, 14-18, 20, 21, 26, 27 and 29-35 have been amended to depend from one of these independent claims. As such, claims 4, 6, 7, 9-21 and 25-35 should now be in condition for allowance. As such no further word regarding claims 4, 6, 7, 9-21, 25-33 and 35 will be made in this Amendment.

In the outstanding Office Action, the Examiner rejected claims 1-6, 22-24 and 36-39, under 35 U.S.C. §102(e), as being anticipated by Davison *et al.* (USP 6,632,193). The Examiner also rejected claims 8, 34 and 40, under 35 U.S.C. §103(a), as being unpatentable over Davison in view of Ellsberry *et al.* (USP 6,432,103). The Examiner's rejections are respectfully traversed.

For a claim to be anticipated by a reference, every element of the claim must be disclosed in the reference. Here, Davison does not anticipate the claims rejected under §102(e) as being

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anticipated by Davison, because Davison does not disclose the range of frequencies recited in amended independent claims 1 and 22 or in independent claims 36, 38, 39 and 40.

By this Amendment, independent claims 1, 22 and 36 have been amended to recite a generator for delivering a radio frequency tissue treatment output in the frequency range from 5MHz to 50 MHz. Support for this amendment appears at least at page 12, line 55, of the present application's specification.

Independent claims 38 and 39 each recite a generator for delivering radio frequency output for the treatment of tissue structures in the "high to very high frequency range". The term "high frequency" is defined as radio frequencies in the 3 to 30 MHz band. THE ILLUSTRATED DICTIONARY OF ELECTRONICS 334 (7th ed. 1997) (Attachment A). The term "very high frequency" is defined as radio frequencies in the range of 30 MHz to 300 MHz. *Id.* at 711.

Davison does not disclose the range of radio frequencies specifically recited in independent claims 1, 22 and 36, or the "high to very high frequency range" recited in independent claims 38 and 39. Rather, Davison discloses a radio frequency power supply shown in Figure 2 that is described as an RF oscillator operating at about 100 kHz. Davison *et al.*, col. 20, ln. 65 to col. 21, ln. 4. But Davison notes that the RF oscillator is not limited to this frequency and may operate at frequencies of about 300 kHz to 600 kHz, with a preferable range of about 400 kHz to about 600 kHz for cardiac applications. See Davison *et al.*, col. 21, lns. 4 to 8. This range would be in the low frequency to medium frequency range of the radio spectrum, see THE ILLUSTRATED DICTIONARY OF ELECTRONICS at 570, and not the 5 MHz to 50 MHz or the "high to very high frequency range" recited in independent claims 1, 22, 36, 38 and 39 of the

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present application. As such, Davison does not anticipate these claims or the dependent claims which depend from these claims, *i.e.*, claims 2, 3, 5, 8, 23 and 24.

With regard to the Examiner's rejection of claims 8, 34 and 40, under 103(a), as being unpatentable over Davison in view of Ellsberry, for a claimed invention to be obvious over a combination of prior art references, there must be some suggestion, motivation or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g., Ashland Oil, Inc. v. Delta Resins & Refracs.*, 776 F.2d 281, 293 (Fed. Cir. 1985). The Federal Circuit has warned against using a claimed invention as a "blueprint" for piecing together elements in the prior art to defeat the patentability of a claimed invention:

As this court has stated, "virtually all [inventions] are combinations of old elements." . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). (Citations omitted). The Federal Circuit has also identified three possible sources for a motivation to combine references:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art

references for combination in the matter claimed. This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

Id. at 1457-58 (Fed. Cir. 1998).

The claimed invention, as described in claims 8, 36 and 40, is also not obvious over the cited reference for at least two reasons. First, in combining Davison with and Ellsberry to reject claims 8, 36 and 40 under §103(a), the Examiner does not rely on any of the three possible sources of motivation to combine references identified by the Federal Circuit. Rather, the Examiner impermissibly uses the claimed invention as a blueprint to piece together elements from such references in an effort to produce the claimed invention. But, even assuming, *arguendo*, that the Examiner properly combined the cited references, the resulting combination still would not be the claimed invention, given the deficiencies in the cited references.

Because claim 8 depends from independent claim 1, given the deficiencies in Davison noted above, a combination of this reference with Ellsberry would not result in the electrosurgery system as described in claim 8 in combination with claim 1.

With regard to claims 34 and 40, these claims recite an active electrode comprising a ceramic body defining an internal cavity, which is lined with metal. The Examiner does not assert that Davison discloses this feature of such claims; and, clearly, Ellsberry also does not teach or suggest this feature of the instrument of claim 34 or the electrode assembly of claim 40. Rather, while Ellsberry talks about ceramic materials, it does so in the contexts of a ceramic insulating support member for the electrodes disclosed in Ellsberry and of a ceramic insulator

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between the active and return electrodes. *See, e.g.*, Ellsberry, col. 5, lns. 48-51, col. 19, lns. 52-58, col. 26, lns. 7-12, and 32-46, col. 30, lns. 52-58, and col. 31, ln. 58 to col. 32, ln. 9. As such, claims 34 and 40 are not rendered obvious by the combination of Davison and Ellsberry.

In view of the foregoing, it is believed that all of the claims remaining in the application, *i.e.*, claims 1-36 and 38-40, are now in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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